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09/459,037	12/10/1999	MASASHI HAMADA	1232-4604	9614

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EXAMINER
DAVIS, TEMICA M

ART UNIT	PAPER NUMBER
2681	

DATE MAILED: 12/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/459,037	Hamada et al.
Examiner	**Art Unit**
Temica M. Davis	2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Dec 10, 1999

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-36 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-36 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-3, 5-7, 9-11, 13-15, 17-24, 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Reece et al (Reece), U.S. Patent No. 5,915,214.

Regarding claim 1, Reece discloses a radio communication apparatus comprising: receiving means for receiving data on a communication line in accordance with a registration sequence with a communication network (col. 11, line 57-col. 12, line 5); and output means for outputting a communication charge in accordance with the data received by said receiving means (col. 13, lines 39-45; figure 7).

Regarding claim 2, Reece discloses the apparatus according to claim 1, further comprising requesting means for requesting a radio a network to send the data on the communication line (col. 11, line 57-67, col. 12, line 45-56).

Regarding claim 3, Reece discloses the apparatus according to claim 2, wherein said requesting means requests the radio network, the procedure of which has been changed, to send the data (col. 11, line 57-67, col. 12, line 45-56).

Regarding claim 5, Reece discloses the apparatus according to claim 1, wherein the data includes data for identifying a connecting network for connecting the communication network and another network which connects a communicating party (col. 17, line 48-col. 18, line 16).

Regarding claim 6, Reece discloses the apparatus according to claim 1, wherein said receiving means receives the data in accordance with a roaming sequence (col. 15, lines 40-48).

Regarding claim 7, Reece discloses the apparatus according to claim 1, wherein said receiving means receives time data on the communication line (col. 13, lines 38-45).

Regarding claim 9, Reece discloses the apparatus according to claim 1, wherein said output means outputs a communication charge per unit of time (col. 6, lines 41-43; figure 7).

Regarding claim 10, Reece discloses the apparatus according to claim 1, wherein said output means outputs a communication charge incurred by handover communication implemented by a roaming service (col. 6, lines 46-58).

Regarding claim 11, Reece discloses the apparatus according to claim 1, wherein said output means stores the communication charge in a removable memory (col. 15, lines 16-30).

Regarding claim 13, Reece discloses the apparatus according to claim 1, wherein said output means outputs a communication history that includes the communication charge (col. 15, lines 16-30).

Regarding claim 14, Reece discloses the apparatus according to claim 1, wherein said output means outputs a communication history in accordance with the data on the communication line (col. 15, lines 16-30).

Regarding claim 15, Reece discloses the apparatus according to claim 1, wherein said output means outputs a communication history that includes information indicating locations where calls are made (col. 15, lines 16-20).

Regarding claim 17, Reece discloses the apparatus according to claim 1, wherein identification data identifying the data communication apparatus is registered in the communication network in the registration sequence (col. 12, lines 57-62).

Regarding claim 18, Reece discloses the apparatus according to claim 1, wherein said receiving means receives the data in an incoming-call sequence (col. 18, line 48-col. 19, line 16).

Regarding claim 19, Reece discloses the apparatus according to claim 1, wherein said receiving means receives the data in an outgoing-call sequence without specifying a connecting network for connecting the communication network and another network to which a communicating party is to be connected (col. 13, line 64-col. 14, line 22).

Regarding claim 20, Reece discloses a method for outputting a communication charge from a radio communication apparatus, comprising the steps of receiving data on a communication line in accordance with a registration sequence with a communication network (col. 11, line 57-col. 12, line 5); and outputting a communication charge in accordance with the data received at said receiving step (col. 12, lines 15-27, col. 13, lines 39-45).

Regarding claim 21, Reece discloses a memory for storing a program comprising steps of: receiving data on a communication line in accordance with a registration sequence with a communication network (col. 11, line 57-col. 12, line 5); and outputting a communication charge in accordance with the data received at said receiving step (col. 12, lines 15-27, col. 13, line 39-45; figure 7).

Regarding claim 22, Reece discloses a radio communication apparatus comprising: receiving means for receiving data on a communication line in accordance with a roaming sequence with a communication network (col. 15, lines 40-48); and output means for outputting a communication charge in accordance with the data received by said receiving means (col. 11, lines 47-54 and col. 13, lines 32-45).

Regarding claim 23, Reece discloses a method for outputting a communication charge, comprising the steps of: receiving data on a communication line in accordance with a roaming sequence with a communication network (col. 15, lines 40-48); and outputting a communication charge in accordance with the data received at said receiving step (col. 11, lines 47-54 and col. 13, lines 32-45).

Regarding claim 24, Reece discloses a memory for storing a program comprising the steps of receiving data on a communication line in accordance with a roaming sequence with a communication network (col. 15, lines 40-48); and outputting a communication charge in accordance with the data received at said receiving step (col. 11, lines 47-54 and col. 13, lines 32-45).

Regarding claim 31, Reece discloses a radio network comprising: connecting means for connecting a radio terminal via a radio channel (col. 11, lines 57-61); and notification means for notifying the radio terminal in a registration sequence of data on a communication line for enabling the radio terminal to calculate a communication charge (col. 12, line 57-col. 13, line 37).

Regarding claim 32, Reece discloses a method for enabling a network to calculate a communication charge, comprising the steps of: executing a registration sequence between a radio network and a radio terminal (col. 11, line 57-col. 12, line 5); and transferring data on a communication line in the registration sequence from the radio network to the radio terminal for enabling the radio terminal to calculate the communication charge (col. 13, lines 39-45; figure 7).

3. Claims 25-30, 35 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Granberg, U.S. Patent No. 6,195,543.

Regarding claim 25, Granberg discloses a radio communication apparatus comprising: receiving means for receiving data on a communication line in accordance with an incoming call (col. 7, lines 41-59); and output means for outputting a communication charge in accordance with the data received by said receiving means (col. 17, line 60-col. 8, line 18, col. 18, lines 40-65; figure 2).

Regarding claim 26, Granberg discloses a method for outputting a communication charge,

comprising the steps of: receiving data on a communication line in accordance with an incoming call (col. 7, lines 41-59); and outputting a communication charge in accordance with the data received at said receiving step (col. 17, line 60-col. 8, line 18, col. 18, lines 40-65; figure 2).

Regarding claim 27, Granberg discloses a memory for storing a program comprising the steps of: receiving data on a communication line in accordance with an incoming call (col. 7, lines 41-59); and outputting a communication charge in accordance with the data received at said receiving step (col. 17, line 60-col. 8, line 18, col. 18, lines 40-65; figure 2).

Regarding claim 28, Granberg discloses a radio communication apparatus comprising: sending means for sending an outgoing-call signal to a communication network (col. 5, lines 38-47); judging means for judging whether a request signal for requesting data on a communication line should be sent by said sending means, this depending upon whether the outgoing-call signal includes data for specifying a connecting network which connects the communication network and another network connecting a communicating party (col. 5, lines 47-55); and output means for outputting a communication charge in accordance with the data on the communication line (col. 5, line 65-col. 6, line 2).

Regarding claim 29, Granberg discloses a method for outputting a communication charge, comprising the steps of: sending an outgoing-call signal to a communication network (col. 5, lines 38-47); judging whether a request signal for requesting data on a communication line should be sent at said sending step, this depending upon whether the outgoing call signal includes data for specifying a connecting network which connects the communication network and

another network connecting a communicating party (col. 5, lines 47-55); and outputting a communication charge in accordance with the data on the communication line (col. 5, line 65-col. 6, line 2).

Regarding claim 30, Granberg discloses a memory for storing a program comprising the steps of sending an outgoing-call signal to a communication network (col. 5, lines 38-47); judging whether a request signal for requesting data on a communication line should be sent at said sending step, this depending upon whether the outgoing call signal includes data for specifying a connecting network which connects the communication network and another network connecting a communicating party (col. 5, lines 47-55); and outputting a communication charge in accordance with the data on the communication line (col. 5, line 65-col. 6, line 2).

Regarding claim 35, Granberg discloses a radio network comprising: connecting means for connecting a radio terminal via a radio channel (col. 5, lines 38-47); and notification means for notifying the radio terminal of data on a communication line for enabling the radio terminal to calculate a communication charge in a case where a connecting network which connects the radio network and another network connecting a communicating party has been specified (col. 5, line 65-col. 6, line 23).

Regarding claim 36, Granberg discloses a method for enabling a network to calculate a communication charge, comprising the steps of: executing an outgoing-call sequence between a radio network and a radio terminal (col. 5, lines 38-47); and transferring data on a communication line from the radio network to the radio terminal for enabling the radio terminal

to calculate the communication charge in a case where the outgoing-call sequence is executed without specifying a connecting network which connects the radio network and another network connecting a communicating party (col. 5, line 65-col. 6, line 23).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 4, 8, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reece et al (Reece), U.S. Patent No. 5,915,214 and well known prior art.

Regarding claim 4, Reece discloses the apparatus according to claim 2 as described above. Reece, however, fails to disclose wherein said requesting means requests the radio network to send data relating to a collect call. Reece, however, discloses wherein a called subscriber unit is charged for an incoming call based on a selected service provider (col. 18, lines 30-33).

Although, Reece is silent to the type of incoming call, the examiner contends that incoming collect calls are well known in the art, and the examiner takes official notice as such.

Therefore, at the time of invention, it would have been obvious to modify Reece with well known prior art as it would have been a design preference as to what type of incoming calls are used in the system.

Regarding claim 8, Reece discloses the apparatus according to claim 1 as described above. Reece, however, fails to disclose wherein said output means outputs a communication charge incurred by a collect call. Reece, however, discloses wherein a called subscriber unit is charged for an incoming call based on a selected service provider (col. 18, lines 30-33), and further discloses wherein the rate of a cost of a call is displayed or outputted to a user (col. 13, lines 38-45).

Although, Reece is silent to the type of incoming call for which the mobile is charged, the examiner contends that incoming collect calls are well known in the art, and the examiner takes official notice as such.

Therefore, at the time of invention, it would have been obvious to modify Reece with the teachings of well known prior art as it would have been a design preference as to what type of incoming calls are used in the system.

Regarding claim 12, Reece discloses the apparatus according to claim 1 as described above. Reece, however, fails to disclose wherein said receiving means receives country data relating to the communication line. Reece, however, discloses wherein the ID of a service provider which is located in the same geographic area as the mobile is sent to the mobile unit in

order for the mobile to recognize the service provider (col. 7, lines 30-43 and col. 12, lines 28-55).

Although Reece does not specifically disclose the ID of the service sent as having country data, the examiner contends, however, that such a technique is very well known in the art for identifying a service provider, and the examiner takes official notice as such.

Therefore, at the time of invention, it would have been obvious to modify Reece with the teachings of well known prior art as it would have been a design preference as to what type of identifying information of the system would be used.

Regarding claim 16, Reece discloses the apparatus according to claim 1 as described above, and further discloses wherein said output means outputs a communication history that includes information indicating charges for calls (col. 15, lines 16-20). Reece, however, fails to disclose history relating to collect calls.

Although, Reece is silent to the type of calls in the history data, the examiner contends that collect calls are well known in the art, and the examiner takes official notice as such.

Therefore, at the time of invention, it would have been obvious to modify Reece with the teachings of well known prior art as it would have been a design preference as to what type of calls are used in the system.

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foti, U.S. Patent No. 6,138,006 in view of Granberg, U.S. Patent No. 6,195,543.

Regarding claim 33, Foti discloses a radio network comprising: connecting means for connecting a radio terminal via a radio channel (col. 3, lines 1-8); and notification means for notifying the radio terminal in accordance with a collect call of data on a communication line (col. 3, lines 49-60).

Foti, however, fails to disclose wherein this data is used for enabling the radio terminal to calculate a communication charge.

Granberg reads on this limitation (col. 5, lines 42-47 and col. 5, line 66-col. 6, line 2).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Foti with the teachings of Granberg for the purpose of knowing how much an incoming call would cost prior to accepting the call.

7. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Granberg, U.S. Patent No. 6,195,543 in view of Foti, U.S. Patent No. 6,138,006.

Regarding claim 34, Granberg discloses a method for enabling a network to calculate a communication charge, comprising the steps of: executing an incoming-call sequence between a radio network and a radio terminal; and transferring data on a communication line from the radio network to the radio terminal for enabling the radio terminal to calculate the communication charge (col. 5, lines 42-47 and col. 5, line 66-col. 6, line 2).

Granberg, however, fails to disclose wherein the incoming call sequence is a collect call.

Foti discloses this limitation (col. 3, lines 49-60).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Granberg with the teachings of Foti for the purpose allowing a user to determine if they want to pay the additional charges.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dennison et al, U.S. Patent No. 6,324,404, discloses a cellular telephone system that uses position of a mobile unit to make call management decisions.

Barber et al, U.S. Patent No. 6,016,427, discloses a preferred carrier selection method.

Vedel, U.S. Patent No. 5,974,308, discloses selective broadcasting of charge rates.

Tiedemann, Jr. et al, U.S. Patent No. 5,862,471, discloses a method and apparatus for providing roaming indication with charge information.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2600 Customer Service whose telephone number is (703)306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for any communications intended for entry).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Temica M. Davis

December 17, 2001

QUOCHIEN VUONG
PATENT EXAMINER